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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
Tsai et al.)
Serial No. : 09/111,305) US Patent 5,974,528
Filed : July 7, 1998) Issued: October 26, 1999
For : MICROCOMPUTER WITH) Docket No.: 252302-1100
EMBEDDED FLASH MEMORY)
HAVING ON-CHIP PROGRAMMING)
CAPABILITY AND METHOD OF)
PROGRAMMING DATA INTO THE)
EMBEDDED FLASH MEMORY)

**Statement in Support
of Petition to Accept Unavoidably Delayed Payment of Maintenance Fee**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is filed in support of the accompanying petition to accept the unavoidably delayed payment of the maintenance fee for U.S. Patent 5,974,528, which expired on October 27, 2003. In short, the reason for the unavoidable delay resulted from the PTO's undue delay and piecemeal examination in a co-pending reissue application, as well as a nearly three-year delay at the U.S. PTO to report the status of the co-pending reissue application, despite repeated status inquiries and petitions from the undersigned attorney.

Relevant Facts

The relevant facts are as follows. U.S. patent 5,974,528 issued on October 26, 1999. After issuance, Applicant discovered certain errors in that issued patent and on October 25, 2001, Applicant filed a reissue application, which reissue application was assigned serial number 09/984,683 (the '683 reissue application).

A third party company (hereafter "Third Party"), at the direction of the assignee (Winbond Electronics Corp.) assumed responsibility for maintenance fee payments for the '528 patent, and the first maintenance fee payment (the 3.5 year maintenance fee) was due to be paid by April 26, 2003 (October 26, 2003, with the six-month grace period included). The Third Party instructed the undersigned that the Third Party would handle all maintenance fees and did not require reminders from the office of the undersigned. In response, all such reminders were removed from the docket system of the office of the undersigned.

However, on Feb. 4, 2003, before the due date of the first required maintenance fee, the assignee was required to file a "Statement of Surrender of U.S. Patent 5,974,728" with the U.S. Patent & Trademark Office, in the co-pending '683 reissue application. That statement stated that "Winbond Electronics Corp. hereby surrenders all rights arising under that patent in lieu of the rights it will obtain through the issuance of this reissue application (serial no. 09/984,683)." This required statement led Winbond Electronics Corp. and/or the Third Party company responsible for paying the maintenance fee to believe that the maintenance fee was no longer required, due to the pendency of the reissue application. Nearly nine months later, on October 27, 2003, U.S. patent 5,974,528 expired.

While the foregoing facts may be believed to fall more squarely into the area of an unintentional, rather than unavoidable, delay, the unavoidable nature of the delay more particularly resulted from the PTO's improper piecemeal examination of the '683 reissue application, and the PTO's ensuing delay to mail an appropriate Order to Show Cause in the '683 reissue application.

In this regard, as early as January 2003, the '683 reissue application was in substantive condition for allowance. To evidence this, attached hereto as Exhibit A is an email dated January 21, 2003, sent from the undersigned's assistant to the undersigned, memorializing the contents of a telephone call from the Examiner to the undersigned's assistant noting that the Examiner only needed a few technical/formal items (e.g., statement of surrender of original patent, annotated version of claim amendment, etc.), and the '683 reissue application would be in condition for allowance. Exhibit A also includes handwritten comments or annotations that were made by the undersigned on or about the time of receipt of the email (approximately January 21 2003).

The undersigned provided the requested information to the Examiner via facsimile. Attached hereto as Exhibit B is a photocopy of the facsimile from the undersigned to the examiner, in which this information was provided. On March 2, 2003, in response to another telephone inquiry from the Examiner, the undersigned submitted another facsimile containing information requested by the Examiner. A copy of that facsimile submission is attached hereto as Exhibit C.

Thereafter, on June 18, 2003, the Examiner mailed another (Final) Office Action rejecting the claims on the basis that the reissue declaration was defective. The undersigned promptly filed a response on June 27, 2003, providing revised reissue

declarations. Copies of this Office Action and response are of record with the PTO in the '683 reissue application, and therefore are not separately attached to this statement.

Thereafter, on November 25, 2003, the Examiner mailed a new, non-Final Office Action, setting forth certain new bases for rejection. These bases again included an objection to the declaration (for newly asserted reasons), improper recapture of subject matter within the claims, etc. On February 25, 2004, the undersigned filed a substantive response to the Office Action and on March 17, 2004, the undersigned provided newly-executed reissue declarations. Again, copies of these documents have been made of record with the PTO in the '683 reissue application, and therefore are not separately attached to this statement.

On November 22, 2004 (some eight months later), the Examiner again mailed another Office Action, continuing to reject the '683 reissue application. On March 8, 2005, the undersigned filed the final response in the '683 reissue application, which placed that application in condition for allowance.

Despite the fact that the '683 patent was in condition for allowance by March 8, 2005, for some three years, the PTO failed to mail any such allowance or any other communication in that '683 reissue application. During the intervening period, the undersigned made periodic and repeated phone calls to the PTO, made repeated status inquiry submissions to the PTO, and even filed two separate petitions, formally requesting the PTO to move along the prosecution of the '683 reissue application. Not a single one of these communications, however, was ever directly responded to by the PTO. Instead, on Feb. 8, 2008, the PTO mailed an Order to Show Cause in the '683 reissue application, which indicated that the underlying '528 patent has expired for

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application Of: Tsai, et al.

Serial No.: 09/984,683

Filed: October 25, 2001

Group No.: 2183

Examiner: El Hady, Nabil M.

Docket No. 252302-1101

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For: **Microcomputer With Embedded Flash
Memory Having On-Chip Programming
Capability and Method of Programming Data
into the Embedded Flash Memory**

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STATEMENT OF SURRENDER OF U.S. PATENT 5,974,528Assistant Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Winbond Electronics Corp. owner of all right, title, and interest in U.S. Patent 5,974,528 has been unable to the original copy of the letters patent for U.S. Patent 5,974,528. However, Winbond Electronics Corp. hereby surrenders all rights arising under that patent in lieu of the rights it will obtain through the issuance of this reissue application (serial no. 09/984,683).

Respectfully Submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

By:



Daniel R. McClure; Reg. No. 38,962

Suite 1750, 100 Galleria Parkway
Atlanta, Georgia 30339-5948
(770) 933-9500**Exhibit B**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application Of: Tsai, et al.

Serial No.: 09/984,683

Filed: October 25, 2001

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AMENDMENT AND RESPONSE TO OFFICE ACTION

Assistant Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

The Office Action mailed July 12, 2002, has been carefully considered. In response thereto, please enter the following amendments and consider the following remarks.

In the Claims

Please cancel claims 35 and 43-44, without prejudice or disclaimer.

Please substitute the following clean-text claims for the pending claims of the same number:

36. (Once Amended) A method for use on a microcomputer, the microcomputer having a microprocessor unit including an embedded flash memory unit, the embedded flash memory unit having a loader block and a user block, the loader block being used to store a loader program, the method comprising the steps of:

 checking whether a request for a data reprogramming process is received; and

Exhibit B

if the request being received,

switching an active block of the embedded flash memory unit to the loader block

by the microprocessor unit to load the loader program;

receiving data required to write and programming the data into the user block of the embedded flash memory unit according to the loader program; and

switching the active block of the embedded flash memory unit to the user block, after the following steps:

determining a period of time to write the data into the user block of the embedded flash memory unit; and

at the end of the determined period, generating an interrupt signal used to switch the active block of the embedded flash memory unit from the loader block to the user block.

38. (Once Amended) The method of claim 37, the step of receiving the data and programming a received block into the user block of the embedded flash memory unit further including:

temporally storing a next block to be programmed in a storing device while a current block sent to be programmed into the user block of the embedded flash memory unit; and

transferring a stored block to be programmed into the user block.

40. (Once Amended) The method of claim 36, wherein after the request being received and before switching the active block of the embedded flash memory unit to the loader block further including:

switching the microprocessor unit to a programming mode; and

enabling an interrupt function of the microprocessor unit, thereby allowing the microprocessor unit to respond to an interrupt signal, wherein the interrupt signal is generated after completing the programming of the data into the user block.

42. (Once Amended) A microcomputer having an on-chip programming capability, the microcomputer comprises:

a microprocessor unit; and

an embedded flash memory unit coupled to the microprocessor unit, the embedded flash memory unit having a loader block and a user block, the loader block being used for storing a loader program, the user block being used for storing at least one application program, wherein

when the microprocessor unit being entered into a programming mode, the loader program being executed and desired data being received by the microprocessor unit from an external circuitry, and

when the microprocessor unit being entered into an idle mode, the received data being loaded into the user block;

wherein after the loader program being executed, the microprocessor unit transmitting the received data into the user block until an interrupt signal being received by the microprocessor unit, the data being received by the microprocessor having at least one block, the interrupt signal being issued depending on a period of time required to program the block into the user block of the embedded flash memory unit.

Please cancel claims 43 and 44.

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The Office Action (paragraph 2) noted that Applicant failed to observe the new amendment practice by failing to underline the entire text of the newly-added claims. However, it appears as though the Office Action proceeded with the entry of those claims, since the claims have been considered and addressed by the Office Action.

The Office Action (paragraphs 3 and 4) noted certain deficiencies in the Consent of Assignee and the reissue declaration. Substitute Consent of Assignee and Reissue Declaration are submitted herewith. These new documents have been signed by Mr. Yung Chin, who is Vice President of the assignee, Winbond Electronics, Corp. Also enclosed is a Declaration of Yung Chin, which expressly states that, as Vice President, of Winbond Electronics, Corp., he is authorized to act on its behalf in this reissue application matter.

Discussion of Claim Rejections

The Office Action (paragraph 7) rejected all claims base upon a defective declaration. The corrected/substitute declaration herewith is effective to overcome these rejections.

The Office Action (paragraph 8) objected to claims 36-40 and 47-50 based on certain, listed informalities. Applicant has made appropriate amendments (above) to correct and overcome the objectionable subject matter listed by the Office Action.

The Office Action (paragraphs 9-10) rejected claims 35-41, 49, 50, 54, and 55 under 35 U.S.C. § 112, second paragraph. Certain of these claims have been canceled herein, rendering moot the rejections as to those claims. Appropriate amendments have been made to address and overcome the rejections as to the remaining claims.

The Office Action (paragraphs 11-19) rejected claims 35, 42, and 45-55 under 35 U.S.C. § 103(a), based on the combination of U.S. Patent Numbers 5,495,593 and 6,073,207. Applicant has amended claim 42 to include the limitations of claims 43 and 44 (and has canceled claims 43 and 44). Since claim 44 was indicated as allowable, claims 42 and 45-55 (which depend from claim 42) are in condition for allowance.

It is believed that all conditions and requirements of the Office Action have been addressed or otherwise complied with herein, and that all pending claims are in proper condition for allowance. If the Examiner believes that a teleconference with the undersigned attorney would expedite the prosecution of this application, the Examiner is invited to contact the undersigned attorney at 770-933-9500.

No fee is believed to be due in connection with this Amendment and Response to Office Action. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully Submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

By:



Daniel R. McClure; Reg. No. 38,962

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Annotate Version of Amended Claims

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Claims 36, 38, and 40 have been amended as follows:

36. (Once Amended) A method for use on a microcomputer, the microcomputer having a microprocessor unit including an embedded flash memory unit, the embedded flash memory unit having a loader block and a user block, the loader block being used to store a loader program, the method comprising the steps of:

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checking whether a request for a data reprogramming process is received; and if the request being received,

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switching an active block of the embedded flash memory unit to the loader block

by the microprocessor unit to load the loader program;

receiving data required to write and programming the data into the user block of

the embedded flash memory unit according to the loader program; and

switching the active block of the embedded flash memory unit to the user block, after the following steps:

determining a period of time to write the data into the user block of the embedded flash memory unit; and

at the end of the determined period, generating an interrupt signal used to switch the active block of the embedded flash memory unit from the loader block to the user block.

38. (Once Amended) The method of claim 37, the step of receiving the data and programming a received block into the user block of the embedded flash memory unit further including:

temporally storing a next block to be programmed in a storing device while a current block sent to be programmed into the user block of the embedded flash memory unit; and
transferring a stored block to be programmed into the user block.

40. (Once Amended) The method of claim 36, wherein after the request being received and before switching the active block of the embedded flash memory unit to the loader block further including:

switching the microprocessor unit to a programming mode; and
enabling an interrupt function of the microprocessor unit, thereby allowing the microprocessor unit to respond to an interrupt signal, wherein the interrupt signal is generated after completing the programming of the data into the user block.

42. (Once Amended) A microcomputer having an on-chip programming capability, the microcomputer comprises:

a microprocessor unit; and
an embedded flash memory unit coupled to the microprocessor unit, the embedded flash memory unit having a loader block and a user block, the loader block being used for storing a loader program, the user block being used for storing at least one application program, wherein when the microprocessor unit being entered into a programming mode, the loader program being executed and desired data being received by the microprocessor unit from an external circuitry, and

when the microprocessor unit being entered into an idle mode, the received data being loaded into the user block;

whercin after the loader program being executed, the microprocessor unit transmitting the received data into the user block until an interrupt signal being received by the microprocessor unit, the data being received by the microprocessor having at least one block, the interrupt signal being issued depending on a period of time required to program the block into the user block of the embedded flash memory unit.

TKHR
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.

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Daniel R. McClure
ext. 259e-mail: dan.mcclure@tkhr.com**FACSIMILE TRANSMISSION**

March 11, 2003

[252302-1101]

TO

Mr. Examiner El Hady
FAX: (703) 746-7238

From

Daniel R. McClure
FAX: 770-951-0933

TEL: (703) 308-7990**TEL: 770-933-9500 (Ext. 259)****RE: Supplemental Response for Serial No 09/984,683***(Message) Dear Examiner El Hady:*

In response to your voice message, attached is a supplemental response, which includes an annotation of all claims added during the reissue application, which remain pending.

It is my understanding that this will place the reissue application in condition for allowance. If you require any further information, please let me know.

*Sincerely,**Dan**Daniel R. McClure, Reg. No. 38,962*

Number of Pages (Including This Cover Sheet): - 8 - Page(s)
PLEASE ACKNOWLEDGE SAFE AND CLEAR RECEIPT OF ALL PAGES.

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INTERNATIONAL PATENT, TRADEMARK AND COPYRIGHT LAW AND RELATED LITIGATION*Huntsville, Alabama**Atlanta, Georgia***Exhibit C**

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Certificate of Facsimile

The following is being submitted via
facsimile to the attention of Examiner El Hady of the
U.S. PTO, at facsimile number (703) 746-7238, on
March 11, 2003.



Daniel R. McClureSUPPLEMENTAL RESPONSE

Assistant Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In a voice message from Examiner El Hady, Examiner El Hady noted that Applicant's prior amendments did not properly reflect the annotations to the claims, which have been added in this reissue application, as the annotations are to reflect changes from the issued patent. Therefore, Applicant attaches a proper annotation of these claims to this response.

Initially, an amendment was filed in this reissue application, which added claims 34-55. Since then, claims 35 and 43-44 have been canceled. Thus, the annotations show only the annotations of claims 34, 36-42, and 45-55. The Office Action mailed July 12, 2002, has been carefully considered. In response thereto, please enter the following amendments and consider the following remarks.

Exhibit C

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Respectfully Submitted,

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& RISLEY, L.L.P.**

By: 

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